

REMARKS

Claims 2 – 18 and 21 - 34 are pending. Claims 1, 19 and 20 were previously canceled. No new matter has been introduced by this amendment into the specification and/or claims.

In response to the Office Action, and based on telephone conferences with the Examiner in April 2006, Applicant has addressed all the issues raised and submits that the present case is in condition for allowance. To wit:

- the § 112 rejection of claims 8, 9, 12, 13 and 23 are rectified through amendments suggested by the Examiner to clarify the scope of the claims;
- the new § 103 rejection of the claims based on Hastings (6,584,450) taken with Elston (6,055,505) is addressed through traverse, argument and/or amendment as noted below.

With the exception of claims 7 and 30, for which no substantial discussion occurred with the Examiner, Applicant has modified all the claims in accordance with the tentative agreement reached with the Examiner in discussions taking place on or about April 26 – 28. Given the present amendments and understandings reached with the Examiner in the various telephone conferences, the undersigned submits that the present claims are clearly patentable over the references of record and earnestly requests early and favorable allowance of this case.

Response for claims 2, 4 – 6, 10 – 11, 13 - 18,

Independent claim 2 has been modified to recite that the user configurable option includes both "... a first choice to automatically trigger a modification of the subscriber rental queue, and a second choice which does not trigger a modification of the subscriber rental queue" to clarify that the configurable option is indeed a limitation which is functionally related to the rest of the claim. To further distinguish over the combination of Hastings/Elston applicant has also amended the claim, per the tentative agreement with the Examiner to include the step of

...further comprising said subscriber selecting one of said first choice or second choice to automatically trigger or not trigger a modification to said subscriber rental queue.

As such function is neither taught nor suggested by Elston Applicant submits that the

claim is clearly in condition for allowance.

With respect to claims 4 - 6 depending from claim 2; dependent claim 4 indicates that the time delay is "predefined"; as the Examiner notes, in Hastings the delay is unpredictable and can vary in accordance with the technology involved. This is clearly not the same as using a predefined delay as set out in claim 4. Dependent claim 5 has been amended to further address the concerns raised by the Examiner and includes language on embedded URLs that permit the subscriber to accept and/or modify any proposed alterations of the subscriber rental queue. Dependent claim 6 has been further amended and should be allowable for at least the same reasons as independent claim 2.

Dependent claims 10, 11 and 13 – 18 should be allowable for at least the same reasons as claim 2. In terms of the indefiniteness issue raised for dependent claim 13: claim 2 recites that the notification is sent based on an affirmative determination under step (b) that a notification is necessary; the plain language therefore makes clear that such notification is not always sent, depending on the subscriber's election. As the specification makes clear, the subscriber can elect to have changes made automatically, without a notification. The critical point is that the invention allows for flexible control for the subscriber over such notifications. Claim 13 merely makes clear that in some embodiments the subscriber can specifically opt out of a notification if he/she wishes even under certain conditions where the subscriber rental queue is actually altered automatically, and thus is not inconsistent with the scope of claim 2 which does not specify such option.

Response for claims 7 and 12

While no substantive discussions were had concerning independent claim 7, Applicant has amended the same to further emphasize differences over the prior art. There is simply nothing in Hastings, Elston or the other prior art concerning:

- ...e. causing said recommender system to interact with the subscriber and provide a playable media title recommendation in response to user input provided within a response to said electronic notification;
- f. adding a playable media title recommendation to said subscriber rental queue in response to subscriber input to said recommender system...

Consequently Applicant submits that such claim should also be allowable. Dependent claim 12 should be allowable for at least the same reasons. For dependent claim 12: given the change to independent claim 7, Applicant submits that the indefiniteness issue raised should be moot.

Response for independent claims 8, 9

Independent claim 8 has been amended in accordance with the tentative agreement with the Examiner to rectify any indefiniteness/prior art concerns. Since neither Elston nor Hastings make any hint or suggestion at the last limitation of the claim:

...generating an item recommendation by the recommendation system and adding the additional playable media item to the subscriber rental queue as needed in accordance with said set of notification rules and said separate set of queue replenishment control rules.

Applicant submits that the claim should be allowable.

Independent claim 9 has also been amended consistent with the Examiner's suggestion and should also be allowable.

Response for claims 21 - 24

Independent claim 21 has been amended in accordance with the tentative agreement with the Examiner to rectify any indefiniteness/prior art concerns. The claim has been further amended to read:

...further comprising said subscriber accepting and/or modifying said proposed alteration based on said directions.

Since neither Elston nor Hastings make any hint or suggestion at the last limitation of the claim, Applicant submits that the claim should be allowable. Dependent claims 22 – 24 should be allowable for at least the same reasons. Claims 22 and 24 are re-phrased so that they now more particularly emphasizes the distinctions over the art of record. For dependent claim 23: given the change to independent claim 21, Applicant submits that the indefiniteness issue raised for dependent claim 23 should be moot.

Response for claims 25 - 29

Independent claim 21 has been amended in accordance with the Examiner's suggestions to rectify any indefiniteness/prior art concerns. The claim has been further amended to read:

...further comprising said subscriber accepting and/or modifying said proposed alteration based on said directions.

Since neither Elston nor Hastings make any hint or suggestion at the last limitation of the claim, Applicant submits that the claim should be allowable. Dependent claims 26 - 29 should be allowable for at least the same reasons. Further with respect to dependent claim 26, Applicant points out that in Hastings, the ability to remove items is not presented in a response to a notification; rather, the subscriber must actually visit the site to alter their queue. Accordingly, such reference does not in fact teach the substance of this claim.

Response for claims 30 - 34

While no substantive discussions were had concerning independent claim 30, Applicant has amended the same to further emphasize differences over the prior art. There is simply nothing in Hastings, Elston or the other prior art concerning:

- ...f. interacting with the subscriber using embedded uniform resource links (URLs) or an electronic response field in said electronic notification so as to allow the subscriber to review playable media title recommendations from said recommender system;
- g. adding one or more playable media titles to the subscriber rental queue based on said playable media title recommendations....

Consequently Applicant submits that such claim should also be allowable. Dependent claims 31 – 34 should be allowable for at least the same reasons.

Conclusion

Applicant has addressed all the outstanding issues presented in the most recent Office Action in a manner consistent with the discussions had with the Examiner on the same. Accordingly, the claims are submitted to be in condition for allowance.

Should the Examiner wish to discuss anything related to this case in person, feel free to contact the undersigned at any convenient time.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Nicholas Gross". The signature is fluid and cursive, with the first name "J." being small and the last name "Gross" being larger and more prominent.

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